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**REMARKS/ARGUMENTS**

By this amendment, claims 79-86 are presented and claims 39-86 are pending; however, the FOA only examines claims 39-74, which were rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (U.S. Patent 5,860,068) in view of Lewine (U.S. Patent 5,784,565) and further in view of [www.fcc.gov/cgb/consumerfacts/cellphonefraud.html](http://www.fcc.gov/cgb/consumerfacts/cellphonefraud.html) ("FCC"). See FOA at 1, 2, and 4. The FOA does not reject claims 74-78, nor does it withdraw them from consideration, and appears to have overlooked these pending claims. If claims 75-78 are not allowed, applicant respectfully requests that the basis for their rejection or objection be stated in the record and applicant afforded an opportunity to respond. In either case, the premature finality of the FOA must be withdrawn until examination or other disposal of all pending claims is putatively complete.

Because the office action should not have been made final, applicant adds new dependent claims 79-86 directed specifically to the context of distributor-carrier/retailer inventory management systems, methods, computer readable media and computer programs. Support for these amendments can be found, *inter alia*, at ¶¶ 02, 16, 33, 35, and 60. No new matter is presented by the amendment. Rule 116 is not believed to be applicable because the finality of the office action was improper. In the alternative, the amendment should be allowed because it places

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the application in better form for appeal.

The FOA fails to appreciate the differences between the claimed invention and the cited prior art. The claimed invention is directed towards a system that allows end-users and retailers to place orders with a distributor of wireless communications devices and review the status of existing orders of serialized wireless communication devices. The MIN or ESN number in the claimed invention is a unique serialized identifier for each unit unlike the generic products in the cited prior art. Applicant discloses use of ESN and MIN "stored in the wireless communication device inventory database." The use of ESN and MIN in applicant's invention is not motivated by concerns over security. Applicant's invention uses the ESN and MIN for inventory tracking purposes such as in a warehouse or other storage or processing facility where stocks of the wireless handsets are maintained for distribution from manufacturers to retailers and ultimately to the end users. Paragraph 60 discloses "detailing the transaction, e.g. MIN and ESN" as using the ESN and MIN for inventory or customer sales purposes, not for security, although a level of security for the ESN/MIN database would certainly be necessary to prevent unauthorized access to and/or querying of the inventory data including any ESN/MIN to which a particular retailer or carrier is not entitled to access.

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Wireless communication device ordering is significantly more complex than typical e-commerce for a generic product. When a retailer or end-user orders a wireless communication device, the distributor typically associates a specific ESN or MIN with the customer's order and assigns a telephone number and/or IP address from the carrier or other service provider to that specific device. In contrast, prior art systems such as Lewine utilize e-commerce for generic items. When a generic item is ordered, it is only important to send the correct make/model to the end-user. If the distributor has 1000 units of a specific make/model generic item, any of the 1000 units can be sent to the end-user. When an end-user orders a wireless communication device, it is important that the end-user receives a specific unit with the appropriate ESN/MIN number programmed for the corresponding telephone number and/or IP address.

None of the prior art references cited provide any teaching or suggestion that Cook or Lewine could be used or modified for use to obtain the presently claimed Customer Controlled Inventory Access system, method, computer readable media, computer program, or the results obtained thereby. In contrast, Cook teaches a system for ordering custom CDs with user-specified audio tracks. Cook's system is not designed to maintain any inventory or inventory tracking. When a customer orders a custom CD, Cook utilizes computer technology to automatically create the

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custom CD from a permanent electronic library of songs. This system inherently contains no inventory in the classical sense because each CD is manufactured on demand by copying the song onto the CD. Moreover, the CD's cannot easily be pre-programmed until the user specifies the songs desired. There is no motivation for a skilled artisan to apply Cook's on-demand CD system to the claimed inventory control and access system for serialized wireless communication devices.

Lewine similarly fails to teach or suggest applicant's claimed invention, and instead discloses a system for utilizing the HTTP protocol to simplify standard e-commerce involving generic items, i.e. the ordering of books. Lewine teaches a system for storing the personal information of an end-user accessing an e-commerce site and "tricking" the browser into sending this personal information with each new click on a hyperlink. Lewine offers no suggestion of suitability or modifiability of this system for serialized e-commerce that can involve a distributor that maintains the inventory, and programs and kits serialized products such as wireless devices, for a retailer or reseller. Lewine offers no suggestion, motivation or guidance for providing a retailer with the means to control access to inventory and inventory database.

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The FCC reference similarly fails to relate to the claimed wireless communication device inventory management system. FCC discloses ESN and MIN in definition form and teaches ESN and/or MIN can be used to fraudulently charge a wireless communication device account with a carrier. This reference does not at all relate to the ordering and inventory management of serialized wireless communication devices, and would have provided no suggestion, motivation or guidance for the alleged modification of Cook and/or Lewine.

Claims 39-74 were rejected over Cook in view of Lewine in further view of FCC. Although discussing only claim 39 in detail, the FOA concedes the novelty of claim 39 in that Cook alone does not teach all the limitations of this claim. Instead, the FOA relies on Lewine for "operably connected" and FCC for MIN and ESN in fashioning an attenuated obviousness rejection.

There is no motivation to combine the elements from Cook, Lewine and FCC because the references are not from analogous arts. Cook discloses a system for producing custom CDs on demand and shipping the CDs to end-users that does not appear to involve any inventory access or database control. In contrast, Lewine discloses a special use of HTML to save an end-user's personal information and prevent re-entry in the context of ordering an inventoried generic item such as books. While Cook, Lewine, and applicant's invention relate to commerce, FCC

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discloses MIN and ESN for illegal use of a wireless communication device account. FCC discloses nothing related to commerce or inventory management or the like. It is improper to combine Cook, Lewine, and FCC together or in any sub-combination, because there is no motivation or suggestion to combine the FCC reference with either Cook or Lewine.

Cook fails to teach an "inventory database" as suggested by the examiner. Cook discloses use of a database "for maintaining transaction information including, without limitation, the identity of each customer accessing the service, the customer's identifying information (e.g., name, address, social security number, credit card information and validation information, personal identification number ("PIN") or other security information), historical information about past purchases or inquiries, playlists for CD-ROMS previously-purchased 'favorites' lists, and the like." col. 6, ll. 35-44. There is no mention or even suggestion of an inventory database as examiner suggests. Additionally, applicant recites a "communication device inventory database." Nothing in Cook teaches or suggests a "communication device inventory database." Applicant respectfully requests reconsideration of the rejection and allowance of all claims.

Lewine fails to teach "operably connected" as required in the claims. Examiner contends that operably connected means "providing convenient access to

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the user". FOA at 3. Claim 39 uses operably connected twice in referring to an operable connection through a computer network or some other software link suitable for two software packages to communicate. Support for this definition is found at ¶ 20 of the specification. ¶ 20 states "the connection medium is a network, such as the Internet. The connection medium 40 may include a modem, network interface card, a satellite system, a cable system, or Intranet connection, or other medium for coupling the client workstation 10 to the server 20." This is drastically different from the supposed "operably connected" teaching of Lewine at "column 2, lines 50-65, i.e. 'profile password' and 'never has to enter it again.'" Lewine does not supply the "operably connected" limitation of claim 39. Without Lewine teaching "operably connected", the examiner has not made a prima facie obviousness showing for claim 39 or any other claim.

Moreover, the FCC reference is not a proper prior art reference even if it did provide the alleged suggestion, which it clearly does not. The FOA contends FCC "discusses the 1998 Act, hence dating the discussed subject material as being from the year 1998." See FOA at 2. Such reliance is improper. MPEP § 2128 (Date of Availability) states that the revision date or the date accessed is the prior art date if no publication date is provided. FCC shows a revision date of October 06, 2003, which does not antedate the effective filing date of this application, and there is no

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evidence of any earlier date for FCC. Furthermore, MPEP § 2128 (Extent of Teachings Relied Upon) specifically prohibits the use of the 1998 Act without providing it as a reference.

Assuming, *arguendo*, FCC were somehow available as prior art, it is still unavailing because there was no motivation to combine this reference with Cook or Lewine and it does not teach the feature suggested by examiner. The FCC reference is an article published in 2003 discussing the cloning of mobile telephones and "Cell Phone Fraud". An artisan building a Customer Controlled Inventory Access system would not have sought out post-dated articles describing post-sale mobile telephone fraud. There is no discussion of computers, databases, software, servers, etc. that would have caused an artisan to seek this article, and certainly no motivation to combine the references with either Cook or Lewine.

Regarding claim 40, applicant respectfully traverses that "such features (XML-RPC, etc.) are well known in the art for the purpose of having effective protocols of information transfer." FOA at 3. The FOA provides no proof of such assertion and it is not "capable of such instant and unquestionable demonstration as to defy dispute." MPEP § 2143.03, citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Unless a proper reference is provided under Rule 104(d)(1), applicant would respectfully request the evidence required under Rule



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104(d)(2). Applicant would further request that the data cited be as specific as possible, *id.*, so as to enable applicant a fair opportunity to dispute any alleged guidance or motivation for utilizing XML-RPC in a customer controlled inventory access system based on ESN/MIN data as claimed in combination with the other features of claim 39. The combination is patentable even if any individual feature may not be per se patentable by itself or in the abstract.

Regarding claims 41-58, applicant traverses that "such features of customer handling are well known in the art for the purpose of effective e-commerce." FOA at 4. The FOA provides no proof of such assertion and it is not "capable of such instant and unquestionable demonstration as to defy dispute." MPEP § 2143.03, citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Unless a proper reference is provided under Rule 104(d)(1), applicant would respectfully request the evidence required under Rule 104(d)(2). Applicant would further request that the data cited be as specific as possible, *id.*, so as to enable applicant a fair opportunity to dispute any alleged guidance or motivation for utilizing, in a customer controlled inventory access system based on ESN/MIN data as claimed in combination with the other features of claim 39 and/or 40: (1) a downloadable advanced ordering client module to facilitate communications between the operably connected customer workstation and the server (claims 41-

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42), (2) the customer workstation sending an inventory/price request to the server (claims 43 and 45), (3) the server sending an inventory/price response to the customer workstation (claims 44 and 46), (4) the customer workstation sending an order status request to the server (claims 47 and 49), (5) the server sending an order status response to the customer workstation (claims 48 and 50), (6) the customer workstation sending an order submit request to the server (claims 51 and 53), (7) the server sending an order submit response to the customer workstation (claims 52 and 54), and (8) a report generation server module operably connected to the server for receiving report requests from a browser located on the customer workstation and sending a report to the browser on the customer workstation (claims 55-56) in html format (claims 57-58). The combinations are patentable even if any individual feature may not be per se patentable by itself or in the abstract.

Regarding claims 59 and 60, applicant traverses that "such feature using MIN and ESN are well known for the purpose of security." FOA at 4. The FOA provides no proof of such assertion and it is not "capable of such instant and unquestionable demonstration as to defy dispute." MPEP § 2143.03, citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). Unless a proper reference is provided under Rule 104(d)(1), applicant would respectfully request

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the evidence required under Rule 104(d)(2). Applicant would further request that the data cited be as specific as possible, *id.*, so as to enable applicant a fair opportunity to dispute any alleged guidance or motivation for utilizing a customer controlled inventory access system based on ESN/MIN data, having a report generation server module operably connected to the server for receiving report requests from a browser located on the customer workstation and sending a report to the browser on the customer workstation, where the report requests and reports are based on an ESN or MIN of a wireless device in a as claimed in combination with the other features of claims 39 and 55/56. The combination is patentable even if any individual feature may not be per se patentable by itself or in the abstract.

Regarding claims 61-74, Applicant traverses the rejection wherein the examiner suggests the claims "are method analogs and computer program analogs of corresponding claims of claims 39-60." Claims 39-60 have their own limitations and it is not axiomatic that method claims, computer readable media claims, and/or computer program claims are unpatentable simply because corresponding system claims are allegedly unpatentable. The FOA unfairly fails to provide any explanation as to how the cited prior art has been applied to support the apparently preconceived conclusion that the subject matter of these claims would have been obvious. Furthermore, claims 39-60 are allowable for the reasons

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stated above, so the premise regarding the rejection of claims 61-74 is improper in any case.

Finally, it is noted that the FOA does not indicate that the examiner has acknowledged or considered the references cited in applicant's information disclosure statement (IDS) filed on July 9, 2001. Another copy of the IDS is submitted for the convenience of the office, along with a copy of the USPTO's acknowledgement postcard; note however, that US patent references submitted with the original IDS are not included in the substitute copy due to recent intervening changes to Rule 98.

In view of the foregoing, reconsideration of this application as amended and allowance of all claims are respectfully requested. Alternatively, withdrawal of the finality of the office action and a new office action regarding claims 75-86 are requested. The undersigned is available by telephone if any remaining issues can be resolved in this manner.

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Respectfully submitted,



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